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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,454	06/11/2001	Mervyn J. Monteiro	4115-161	2105

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INTELLECTUAL PROPERTY / TECHNOLOGY LAW
PO BOX 14329
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

DAVIS, MINH TAM B

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/878,454

Applicant(s)

MONTEIRO ET AL.

Examiner

MINH-TAM DAVIS

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: 35.

Claim(s) rejected: 1,2,9,12,23-25,27,28,33 and 34 for reasons already of record, because the amended claims are not and will not be entered.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendment of 04/12/04 is not and will not be entered because the amendment raises the following new issues:

1) Due to the language "at least" and the mutation "comprising", the amended claim 35 would be rejected under 112, first paragraph, because claim 35 reads on a purified mutant calcium-binding protein, having any substitution at any amino acid residue at any position, and not limited to the replacement from the acid residue to its amine counterpart at residue 127. It is noted that the objection in the previous Office action indicated that claim 35 would be allowable only if it does not depend or has the property of non-allowable claim 33.

2) The formality of the amendment of claim 35 is improper, because all the newly added words are not underlined, and the deletion of "or 172" is not included in the claim.

3) The amended claims 24, 33 now belong to non-elected species, and would not be examined if the claims were entered, because they are drawn to the non-elected species a mutant having replacement at position 172, and a method for reducing apoptosis using said mutant.

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RECONSIDERATION OF SPECIES

Applicant requests that the presently examined mutation at residue 127 and the species mutation at residue 172 be considered together, because the cited references do not anticipate a mutation at either residue.

Applicant's arguments have been considered but are found not to be persuasive for the following reasons:

It is noted that there is a 102 rejection for the pending claims. Since there is prior art recited for the claims related to the first species, the second species would not be considered.

The following are the remaining rejections.

REJECTION UNDER 35 USC 112, FIRST PARAGRAPH, SCOPE

Claims 1-2, 9, 12, 23-24, 27-28, 33-34 remain rejected under 112, first paragraph for reasons already of record in paper of 02/10/04.

Applicant argues that the amended claims clearly define that the substitutions are at amino acid residue 127 or 172, both of which are enabling substitutions of SEQ ID NO:2.

Applicant's arguments are moot in view that the amended claims are not and will not be entered.

REJECTION UNDER 35 USC 102

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Claim 12 remains rejected under 35 USC 102(a or b) as being anticipated by Seki et al, 1998, Saito et al, 1999, or Naik, et al, 1999 for reasons already of record in paper of 02/10/04.

Applicant argues that the amended claim 12 now recites a purified mutant calcium-binding protein comprising an amino acid sequence as set forth in SEQ ID NO: 2 and having a substitution at residue 127 or 172 of SEQ ID NO: 2.

Applicant argues that the claimed sequence and the cited sequences have multiple differences.

Applicant's arguments are moot in view that the amended claims are not and will not be entered.

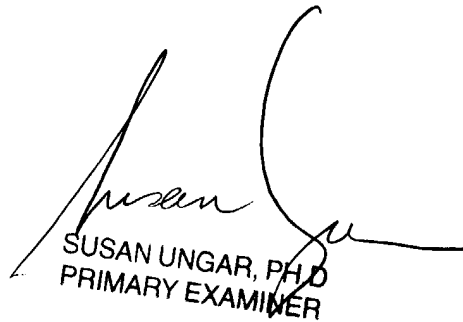
Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MINH TAM DAVIS
August 02, 2004



SUSAN UNGAR, PH.D
PRIMARY EXAMINER